

stores a message corresponding to each of the sending sources registered in memory, and sends a stored message corresponding to the sending source when a controller detects that the sending source has been registered.

Although the Examiner interprets Salgado as teaching the print job containing information indicative of a sending source and a plurality of output mail bins, the Examiner admits that Salgado fails to teach the print job containing information indicative both of a sending source and an output destination and a messaging unit for outputting the message corresponding to the sending source when the controller detects that the sending source has been registered. Hasegawa, even if combined with Salgado, only discloses notification to another user when one of the paper-supplying trays currently being exclusively used is designated by another user. That is not applicant's invention.

The Examiner asserts Hasegawa teaches the print job containing information indicative of a sending source and output destination (col. 4, lines 55-58) and a messaging unit for outputting the message corresponding to the sending source when the controller detects that the sending source has been registered (step 13 of S13 in fig. 4). The Examiner states: "It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Salgado in order for the print job to include the output destination and message is [sic] outputted corresponding to the sending source as taught by Hasegawa. The suggestion for modifying the system of Salgado can be reasoned by one of ordinary skill in the art as set forth above by Hasegawa because such modification would increase the efficiency of the system when allowing the user can [sic] deliver the print job to his desired location and get a message based on the status of that print job." (Action at page 3.)

Applicant respectfully disagrees. Salgado, at col. 12, lines 1-6, states that each output mailbox can be frequently checked for reassignment of that bin to a new user. This does not relate in any way to what is claimed. Salgado merely discloses that if it can be determined a bin

is empty, the bin assignments can be changed. Salgado teaches no message that is output that corresponds to the sending source when the controller detects that the sending source has been registered. Accordingly, Salgado fails to teach or suggest this feature.

Even if the resulting combination suggested by the Examiner included all the claim limitations of claim 1, there is no evidence of the necessary motivation to combine. Salgado is directed to a system in which the user has an assigned output mailbox bin, thus the identification of which user sent the print job is all that is needed to direct the print job to the correct output mailbox bin. This ensures the print job will be delivered to the desired location. It would be unnecessary to include information about the output destination in the print job because the purpose of Salgado is to assign the mailbox bin before the print job is sent. Adding this additional bit of information would not add any value to the system of Salgado. Thus, there would not have been any motivation to combine Salgado and Hasegawa as suggested by the Examiner.

Finally, the Examiner has failed to provide substantial evidence required to support an obviousness rejection. As mentioned above, the Examiner states in the Action that persons of ordinary skill in the art would have been motivated by Hasegawa to modify the structure disclosed in Salgado to arrive at the claimed invention because such modification would increase the efficiency of the system. The Examiner's alleged motivation is so general in the context of the relevant art as to constitute no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Under *Lee*, the Examiner must present *specific* evidence of motivation, not the kind of generalized allegation of motivation relied on in the pending Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central

question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ‘237 patent, col. 4, ll. 34-38.

The reliance in the pending Action on the alleged routine skill in the art to increase the efficiency of the system comes nowhere close to what *Lee* and *Thrift* require. It is not sufficient to say without evidentiary support, as the Examiner does in the pending Action, that “[t]he suggestion for modifying the system of Salgado can be reasoned by one of ordinary skill in the art as set forth above by Hasegawa because such modification would increase the efficiency of the system when allowing the user can [sic] deliver the print job to his desired location and get a message based on the status of that print job.” First, the invention relates to providing notification messages to users of printers, not to paper handling systems generally. Second, the Examiner has pointed to no disclosure in Hasegawa, the alleged evidence of such a motivation, that would have motivated a person of ordinary skill in the art to use its supposed paper-

supplying tray design so as to arrive at the claimed invention.¹ Applicant's invention may be a straightforward and elegant solution to the problem it addresses, but the cited prior art is devoid of a suggestion to make it. Accordingly, the invention as claimed is patentable over the prior art, and claim 1 should be allowed.

Claim 2 is allowable for the same reasons claim 1 is allowable, and further due to its dependency.

Claim 3 recites the same features discussed above in connection with claim 1, and is therefore allowable for the same reasons.

Claims 4-10 are allowable at least due to their respective dependencies.

Claim 11 recites selecting a message from among a plurality of messages preregistered for a plurality of output destinations, said selection being done based on the output destination information contained in the print job to be executed. As stated above, Salgado does not teach that the output destination is part of the print job and there would not have been any motivation to combine the references to create the claimed printing system.

Claim 12 is also allowable for the reasons discussed above. Claims 13-16 are allowable at least due to their respective dependencies.

Claim 17 recites some of the same features discussed above in connection with claim 1 and is allowable for the same reasons. Furthermore, claim 17 recites that the printer is instructed to print when the sending source is registered. By implication, if the sending source is not registered, the print job will not be completed. The Examiner asserts that this feature is taught

¹ Applicant recognizes that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much "hindsight" is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art *itself* as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicant's position rests on the Examiner's failure to produce and rely on objective evidence of motivation in the prior art itself.

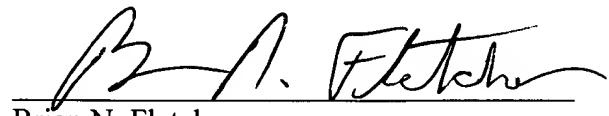
by Hasegawa. However, there would have been no motivation to modify Salgado in light of Hasegawa for the reasons set forth above. Namely, before the print job is sent in Salgado, the bin is assigned to a user. Thus, it is not necessary to actually check to see if the sending source is registered because that is already preset and thus it will be assumed that the source is registered. This would add no value to Salgado.

Claims 18-31 are allowable at least due their respective dependencies. Claim 32 is allowable for the same reasons claim 17 is allowable. Claim 34 is allowable at least due to its dependency from claim 32.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, Applicant respectfully requests the Examiner withdraw the outstanding rejection of the claims and solicits early action in the form of a Notice of Allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **325772015300**.

Respectfully submitted,



Brian N. Fletcher
Registration No. 51,683

Dated: August 18, 2004

Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7796
Facsimile: (703) 760-7777